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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

MAIL DATE	DELIVERY MODE
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11/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/823,704

Applicant(s)

ITO ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-42, 44, 46, 47, 50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-42, 44, 46, 47, 50 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims Status

Claims 40-42, 44, 46, 47, 50 and 51 are pending. Claims 1-39, 43, 45, 48, 49 and 52-55 have been cancelled. Claims 40-42, 44, 46, 47, 50 and 51 are rejected as detailed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 41 includes a musical score. The specification does not describe how to select a time portion of the musical score. Musical score is simply musical text and thus does not have associated time.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40, 42, 44, 47, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,502,194 (Berman et al), hereafter Berman in view of Applicant admitted prior art (AAPA).

Claims 40, 42, 44, 50 and 51:

Berman discloses:

receiving from said client terminal, first request information designating a desired single music piece [Berman: song list, col 7, lines 15-35],

on the basis of said first request information received from said client terminal, transmitting to said client terminal display information for displaying an entire time length of the desired single piece so that the entire time length of the desired single music piece can be displayed on said client terminal on the basis of the display information [Berman: song list, col 7, lines 15-35]

receiving from said client terminal second request information designating a desired time portion of the displayed music piece, said desired time portion being selected by a user of said client terminal from the displayed entire time length of the desired single music piece [Berman: selecting a track, col 7, lines 15-35, downloading the first few seconds of each track, col 8, lines 55-60,]

on the basis of a complete music piece data file corresponding to said desired single music piece and in accordance with said second request information received from said client terminal, creating partial music piece data file corresponding to the desired time portion designated by said second request information [Berman: buffering begins after the user selects one or more songs for listening, col 11, lines 45-55]

transmitting the created partial music piece data file to the client terminal [Berman: Fig 3, step 314, col 7, lines 25-35]

Berman discloses the elements of the claimed invention as noted above but does not disclose on the basis of said second request information determining a selling price of the created partial music piece data file wherein the selling price of the created partial music piece data file being less than a selling price of the complete music data file and wherein the selling price of the created music piece data is dependent upon one of a length and a location of said desired time portions. Applicant as admitted prior art discloses a billing process server 103, Fig 23, paragraph 8]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berman to include on the basis of said second request information determining a selling price of the created partial music piece data file wherein the selling price of the created partial music piece data file being less than a selling price of the complete music data file and wherein the selling price of the created music piece data is dependent upon one of a length and a location of said desired time portions based on the teachings of AAPA for the purpose of providing a commercial website which sells music piece(s) to one or more clients.

Claim 47:

The combination of Berman and AAPA discloses the elements of the claimed invention as noted above but does not disclose wherein the predetermined billing-related information is at least one of a credit card number, an address to which an application form for remittance is to be sent, and user information for use of electronic money. Official Notice is taken that a credit card is a well-known and expected means for making payment for goods and/or services.

Claims 41 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Berman and AAPA as applied to claims 40 and 44 and further in view of US Pat No 6,096,962 (Crowley), hereafter Crowley.

Claim 41, 46:

The combination of Berman and AAPA discloses the elements of the claimed invention as noted above but does not disclose wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score. Crowley discloses a partial musical file as a score [Fig 2A, abstract, Claim 1]. It would have been obvious to one of ordinary skill in the art at the time the invention to modify the above combination of references to include wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score based on the teachings of Crowley for the purpose of constantly evolving a game's musical score [Crowley, abstract].

Response to Arguments

Applicant's arguments submitted 10/11/2007 have been carefully considered but are not persuasive for the following reasons.

Applicant Argues:

Applicant states in the third paragraph of page 9 "It is inherently understood that designation of a particular portion of a musical score would necessarily involve a designation of time information that correspond to the selected portion."

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Examiner Responds:

Examiner is not persuaded. Claim 41 further limits the “music piece” of claim 40 to a musical score. Examiner maintains that one of ordinary skill in the art would not (emphasis added) consider “creating partial music piece data file corresponding to the desired time portion designated by said second request information” to be inherent (emphasis added) specifically when the music piece data file is a musical score. A musical score is musical text and text cannot be associated with time.

Applicant Argues:

Applicant states at the bottom of page 9, “Berman does not contain any disclosure of a method of supplying music piece data over a network whereby a user designated desired time portion of a music piece, of which the entire time length is displayed for designation by the user.”

Examiner Responds:

Examiner is not persuaded.

Berman discloses *user designated time portion of a music piece*

column 8, lines 55-60:

The downloading tasks may include, for example, downloading the first few seconds of each track on a current selected disc to reduce the latency time when one of the tracks is later selected by the user. Such samples from the tracks may be stored in the memory of the playback unit for later listening

Berman discloses *of which the entire time length is displayed for designation by the user*

column 7, lines 20 – 30:

With a confirmed current song list, the user is now permitted to select a track from among those available in a selection menu. The selection menus are displayed, for example, on the display area of the interface illustrated in FIG. 2. The user may need to scroll up and down the displayed selection menu list. Tracks can be selected by artist, genre, disc name, or a number of other factors. The operation of a user making an artist and song selection is represented by the flow diagram box numbered 310.

The user is able to select a track and as is well-known in the art, selecting a track will select the entire length of the track because the user-requested song occupies the entire length of the track and obviously the user wants to hear the entire song.

The following disclosure by Berman is relevant, col 5, lines 50-55:

The display interface has a display area 208 on which playback status information is shown. For example, FIG. 2 shows the display area 208 with a list of song or selection name, track number, artist name or disc (compilation), and song playing time.

The above disclosure by Berman reads on the above claim language *of which the entire time length is displayed for designation by the user*, specifically the disclosure of “song playing time.”

Applicant Argues:

Applicant states at the top of page 10 that “Berman does not teach or suggest creating partial music piece data corresponding to the selected time portion that is designated by a user.”

Examiner Responds:

Examiner is not persuaded. The claim language "partial music piece" is not supported by the specification. Furthermore, "partial music" and "partial piece" is not supported by the specification. The above "partial music piece data" will be interpreted per the following excerpt from paragraph 83 of the specification.

In other words, once the user selects the portion to be purchased from the displayed playback data file, only the data of the selected portion (i.e., a partial musical composition data file comprising partial playback data and musical score data) are produced from the playback data file, and a necessary procedure is taken for purchase of the partial playback data file and musical score data corresponding to the partial playback data file. The price of the partial musical composition data file (i.e., playback data and musical score data) is set depending on the length and position of the selected portion in the complete musical composition data file.

The claim language "partial music piece data" is simply the user-selected music product which the user selects for purchasing.

Berman discloses the following in col 6, line 65 through col 7, line 35:

In the first operational step, represented by the flow diagram box numbered 302, the user selects a music category or type of song desired for playback from a list. This list may include categories such as the artist, the song title, the album, and musical genres. In addition, the user may limit search results by confining the query to specific, user-defined categories. The generated list appears on the display area of the user interface. In the next step, the playback unit sends the version of the current song list to the directory and user list (DUL) server 107, shown in FIG. 1. During this step, the DUL server also can perform user list checks and authorization confirmation, if desired. In this way, the DUL server acts as a "gatekeeper" to ensure that only appropriate users are being granted access to the audio material, thereby ensuring commercial music interests and artists have desired control over distribution. The flow diagram box numbered 304 represents this operational step.

At the decision box numbered 306, the DUTL server checks to determine if the received song list is current. If the song list is not current, a negative outcome at the decision box 306, then a new song list is available and the server sends back an updated song list, as represented by the flow diagram box numbered 308. If the playback unit song list is already current, an affirmative outcome at the decision box 306, then no song list data transmission from the DUL server is

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needed. With a confirmed current song list, the user is now permitted to select a track from among those available in a selection menu. The selection menus are displayed, for example, on the display area of the interface illustrated in FIG. 2. The user may need to scroll up and down the displayed selection menu list. Tracks can be selected by artist, genre, disc name, or a number of other factors. The operation of a user making an artist and song selection is represented by the flow diagram box numbered 310. At the next step, represented by the flow diagram box numbered 312, the playback unit sends the user-requested song title information to the DUL server. The DUL server returns the network address for the requested song. This step is represented by the flow diagram box numbered 314. The playback unit is now ready to retrieve audio material from the network. The flow diagram for these operations continues in FIG. 4.

Berman clearly discloses the limitation ““partial music piece data”

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

11/5/2007



**ETIENNE LEROUX
PRIMARY EXAMINER**